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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,080	04/26/2001	Philippe J. Goix	A-69516/AJT	9621

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EXAMINER

GABEL, GAILENE

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 08/29/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/844,080

Applicant(s)

GOIX ET AL.

Examiner

Gailene R. Gabel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 12-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Amendment Entry***

1. Applicant's amendment and response filed 4/2/03 in Paper No. 11 is acknowledged and has been entered. Claims 1, 4-7, 34, and 35 have been amended. Claims 12-33 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being claims drawn to a non-elected invention. Currently, claims 1-37 are pending. Claims 1-11 and 34-37 are under examination.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35, preamble, is non-idiomatic and, therefore, confusing in reciting, "including".

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 5, 8, and 34 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goix (WO 98/57152) for reasons of record.
4. Claims 6 and 9-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over 1) Goix (WO 98/57152) in view of Hirako (US 5,135,302) for reasons of record.
5. Claims 35-37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over 1) Goix (WO 98/57152) in view of Bernstein et al. (US 5,478,750) for reasons of record.
6. Claims 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over 1) Goix (WO 98/57152) in view of Mochida et al. (US 5,147,607) for reasons of record.
7. Claims 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over 1) Goix (WO 98/57152) in view of von Behrens et al. (US 5,378,633) for reasons of record.

***Response to Arguments***

8. Applicant's arguments filed 4/2/03 have been fully considered but they are not persuasive.

A) Applicant argues that Goix does not anticipate the claimed invention. Specifically, Applicant argues that Goix's apparatus teaches use of a pump such as a syringe pump, for injecting a test sample through the capillary, which is not taught in the claimed invention.

Contrary to Applicant's argument, the claimed invention and the specification at page 7, line 28 to page 8, line 25, recite and describe a syringe pump such as taught by Goix. No patentable distinction is seen. Further, a recitation of the intended use of the claimed "pump" must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

B) Applicant argues that Goix's apparatus is distinct from the claimed invention because the apparatus of Goix requires and needs a larger volume of sample to fill the pump than that needed for analysis.

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In response, the claimed apparatus does not recite the feature upon which applicant relies, i.e. a volume requirement for analysis. Accordingly, claim 1 does not exclude the teaching of Goix.

C) Applicant argues that Goix's apparatus requires a disposable pump to prevent cross contamination or mixing of the sample and a thorough washing of the pump is required between sample analyses.

In response, the claimed apparatus does not recite the feature upon which applicant relies, i.e. a disposable pump, washing requirement. Accordingly, claim 1 does not exclude the teaching of Goix.

D) Applicant argues that the claimed apparatus draws the sample into suspended end of the capillary directly from the sample vial; thus, avoiding mixing or cross-contamination. Applicant contends that the claimed invention calls for a pump connected to the first end of the channel for drawing sample into the second end of the channel; such an arrangement is not taught by Goix.

In response, Goix teaches a pump system connected (coupled) to the first end of the channel for drawing sample into the second end of the capillary channel in page 6, lines 18-26 and Figure 2A. Accordingly, no patentable distinction is seen.

Accordingly, the claimed invention is taught by Goix and further rendered obvious by the combinations of Goix with Hirako, Bernstein, Mochida, and von Behrens.

9. No claims are allowed.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0169.

Gailene R. Gabel  
August 27, 2003

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*Christopher L. Chin*

CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP ~~1800~~ / 641